

Application No. 10/001,572

REMARKS

Claims 1 to 20 are pending in the application. The Examiner has subjected the claims to a restriction requirement and claims 18 to 20 have been withdrawn from consideration. In addition, the claims have been subjected to an election of species requirement, and claims 5 to 13 have been withdrawn from consideration.

The Examiner has stated that the scope of the invention of the elected subject matter is compounds of Formula I wherein the hydrophilic moiety is a polyethylene oxide chain, the lightfastness moiety is a hydroxybenzophenone, and R1 to R12 are as defined, that as a result of the election and the corresponding scope of the invention identified, the remaining subject matter of claims 1, 2 to 4, and 14 to 17 is withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to nonelected inventions, and that the withdrawn compounds contain varying functional groups such as pyridine, triazine, triazole, and the like, which are chemically recognized to differ in structure and function. The Examiner has stated that claims 1, 2 to 4, and 14 to 17 are objected to for containing elected and nonelected subject matter, and that claims drawn solely to the elected invention as identified above would appear allowable.

Applicants respectfully traverse the objection to claims 1, 2 to 4, and 14 to 17. Applicants point out that neither 37 C.F.R. §1.142(b) nor the M.P.E.P. provide for requiring an Applicant to amend a generic claim to encompass only an elected species. Rather, upon allowance of a generic claim, Applicants are entitled to rejoinder of nonelected species claims and allowance thereof as well. See, e.g.:

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M.P.E.P. §806.04(d): "Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.":

M.P.E.P. §809: "Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. . . . The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability." (emphasis added)

M.P.E.P. §809.02(a), quoting from paragraph 8.01: "Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141." (emphasis added)

M.P.E.P. §809.02(c)(B): "When a generic claim is subsequently found to be allowable, and not more than a reasonable number

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of additional species are claimed, treatment shall be as follows: (1) When *all* claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim." (emphasis in original)

M.P.E.P. §809.04: "If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim."

Note also that 37 C.F.R. §1.141(a) states that "Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§1.75) or otherwise include all the limitations of the generic claim." Accordingly, Applicants respectfully request complete examination of the generic claim of the instant application (claim 1) and consideration of all of the species claims that are encompassed therein. In the alternative, and at the very least, Applicants believe that they are entitled to consideration and examination of all subspecies encompassed within Formula 1.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Applicant(s) attorney, Judith L. Byorick, at Telephone Number (585) 423-4564, Rochester, New York.

Respectfully submitted,


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